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10/707,181	11/25/2003	Milton Rodriguez	VIC100001000	1180

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LAW OFFICE OF DELIO & PETERSON, LLC.
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EXAMINER

NGAMPA, BRIGET P

ART UNIT	PAPER NUMBER
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1792

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10/11/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/707,181

Applicant(s)

RODRIGUEZ, MILTON

Examiner

Briget P. Ngampa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 11/25/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-11 and 15-23 is/are rejected.
- 7) ☐ Claim(s) 2,12 and 13-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/26/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 3, 6 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin et al. (patent number 5,885,677 hereafter '677) in view of Torgersen et al. (4,303,701, hereafter '701), and further in view of Liu et al. (pub number US 2002/0114929 A1 hereafter '929).

With respect to claim 1, '677 teach a method of identifying security label by identifying pattern that diffuse into the substrate [col 1, line 48-49]:

Forming an identification mark (security label) on a surface [col1, lines 56-57]: An adhesive layer which substantially covers the major surface [col 2, line 3-5] contains an identifier medium (fluorescent dye) [col 2, line 4-5] is applied to the first major surface [col 1, lines 57-58]. '677 teach that the UV-fluorescent dye readily penetrates painted metal surface [col 5, lines 12-14].

'677 does not teach applying a solution of the fluorescent material to the surface to migrate into the at least one paint layer, and removing the excess amount of fluorescent material from the at least one paint layer with a solvent.

'701 teach applying a solution of the fluorescent material to the surface [col 1, line 62-63] to migrate into the surface to be marked with the identification [col 1, line 66]; and

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removing the excess amount of fluorescent material from the at least one surface [col 1, line 66-68] with a solvent [col 2, line 48]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the fluorescent material to the surface and removed the excess with a solvent with reasonable expectation of success because '701 teaches that it is the suitable method of applying and removing excess fluorescent material.

'677 in view of '701 does not teach that fluorescent emission is visible at an acute angle to the object surface without use of an ultraviolet light, while being substantially invisible at an angle normal to the object surface.

'929 teach that fluorescent ID markers may be visible at an acute angle to the object surface [Fig 1, 26 and fig 3] without use of an ultraviolet light, while being substantially invisible at an angle normal to the object surface [fig 1, 24 and fig 2]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used such selective transmission to increase security and verification of article because '929 teaches that such selective transmission increases security and verification of article.

With respect to claim 3, '677, '701 and '929 teach the limitations of claim 1. '701 further teach the object may be at ambient temperature when the fluorescent material is applied to it [col 3, lines 37-38].

With respect to claim 6, '677, '701 and '929 teach the limitations of claim 1. '677 further teach that numbers and letters (alphanumerics or VIN) within the UV-fluorescent

[col 6, line 53-55]; [fig 3, 92] are applied to the adhesive layer. It is conventional to apply vehicles identification numbers (VIN) in both known and unrevealed location of various auto parts in order to add security and VIN are always a mix of letters and numbers; thus it would have been obvious to apply identification marks with a mix of letters and numbers on the parts because using numbers and letters to produce an identification mark is well known.

With respect to claim 17, '677 teach a method of identifying security label by identifying pattern that diffuse into the substrate [col 1, line 48-49]:

Forming an identification mark (security label) on a surface [col1, lines 56-57]: An adhesive layer which substantially covers the major surface [col 2, line 3-5] contains an identifier medium (fluorescent dye) [col 2, line 4-5] is applied to the first major surface [col 1, lines 57-58]. '677 teach that the UV-fluorescent dye readily penetrates painted metal surface [col 5, lines 12-14].

'677 does not teach applying a solution of the fluorescent material to the surface to migrate into the at least one paint layer, and removing the excess amount of fluorescent material from the at least one paint layer with a solvent.

'701 teach applying a solution of the fluorescent material to the surface [col 1, line 62-63] to migrate into the surface to be marked with the identification [col 1, line 66]; and removing the excess amount of fluorescent material from the at least one surface [col 1, line 66-68] with a solvent [col 2, line 48]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the fluorescent material to the surface and removed the excess with a solvent with reasonable

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expectation of success because '701 teaches that it is the suitable method of applying and removing excess fluorescent material.

'677 in view of '701 does not teach that fluorescent emission is visible. '929 teach that fluorescent ID markers may be visible, [Fig 1, 26 and fig 3]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used such selective transmission to increase security and verification of article because '929 teaches that such selective transmission increases security and verification of article.

2. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin (patent number 5,885,677 hereafter '677) in view of Torgersen et al. (4,303,701, hereafter '701) further in view of Liu et al. (pub number US 2002/0114929 A1 hereafter '929) and further in view of Cleary (patent number 5,811,152, hereafter '152).

'677, '701 and '929 teach the limitation of claim 1. They do not teach that the fluorescent material is a liquid, and the solvent is non-aqueous. '152 teach that the fluorescent material is soluble in a solvent system [col 2, lines 52-53], and the solvent is a volatile solvent [col 4, line 40-41] to produce a unique formulation. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a liquid fluorescent material, non aqueous solvent with reasonable expectation of success, because '152 teaches that it is a suitable method to produce a unique formulation.

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3. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin (patent number 5,885,677 hereafter '677) in view of Torgersen et al. (4,303,701, hereafter '701), further in view of Liu et al. (pub number US 2002/0114929 A1 hereafter '929) further in view of Howse et al. (patent number 5,759,613 hereafter '613).

'677, '701, and '929 teach the limitations of claim 1. '677 further teach that fluorescent dye can penetrate painted metal surface [col 5, lines 12-14]. They do not teach specifically that the metallic surface is that of a vehicle. '613 teach that the vehicle identification number (VIN) is provided on the engine or chassis of a vehicle [col 1, line 50-55]. Therefore it would have been obvious to one of ordinary skills in the art at the time the invention was made to have painted the metallic surface of a vehicle with reasonable expectation of success because '613 teaches that metal is a suitable material for strength and environmental conditions.

4. Claim 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin (patent number 5,885,677 hereafter '677) in view of Torgersen et al. (4,303,701, hereafter '701) further in view of and Liu et al. (pub number US 2002/0114929 A1 hereafter '929) and further in view of Van Duynhoven (U.S. patent number 6,358,563, B1, hereafter '563).

'677, '701 and '929 teach the limitations of claim 1. They do not teach that the fluorescent material is a liquid, and the unique discrete identification is applied to the paint layer by brush. '563 teach that luminescent paint can be applied by brush [col 2, line 63-64] and stencil [col 3, line 8]. Therefore, it would have been obvious to one of

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ordinary skill in the art at the time of the invention to have used a brush or a stencil to apply luminescent paint because '563 teaches that it is a suitable method for luminescent paint application.

5. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin (patent number 5,885,677 hereafter '677) and Torgersen et al. (4,303,701, hereafter '701) for the reasons discussed in claim 1 and further in view of Van Duynhoven (U.S. patent number 6,358,563, B1, hereafter '563) for the same reasons given for claim 7.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin (patent number 5,885,677 hereafter '677) in view of Torgersen et al. (4,303,701, hereafter '701) further in view of Liu et al. (publication number US 2002/0114929 A1 hereafter '929) and Van Duynhoven (U.S. patent number 6,358,563, B1, hereafter '563) as applied to claim 8 and further in view of Sims (patent number 2,438,828 hereafter '828).

'677, '701, '929 and '563 teach the limitations of claim 1. They do not teach how to make the stencil.

'828 teach the stencil being created as:

a) providing a stencil sheet (stencil main body) [fig 1, 15] having an adhesive backing layer [23, 23a] attached to a release sheet [27] [col 2, line 19-23],

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b) cutting the alphanumeric identification [13, 14] into the stencil sheet [fig 1, 15] without cutting through the release sheet [col 1, line 47- col 2, line 19] (mark with opening that mark portions of the surface),

d) placing the stencil sheet [15] with cut alphanumeric identification and adhesive backing layer onto a second adhesive layer [24], [col 2, lines 23-28], and

c) removing the stencil sheet [15] with cut alphanumeric identification and adhesive backing layer from the release sheet [27], [col 3, lines 10-12],

e) removing the stencil sheet and adhesive backing layer without the cut alphanumeric identification from the second adhesive layer [24] creating cut openings [21, 22] on the stencil sheet [col 3, line 16-22] and leaving the cut alphanumeric identification on the second adhesive layer [fig 5]. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the stencil as made by '828 because '828 teaches that it is a suitable process for achieving accurate and consistent lettering.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin (patent number 5,885,677 hereafter '677) in view of Torgersen et al. (4,303,701, hereafter '701), further in view of Liu et al. (pub number US 2002/0114929 A1 hereafter '929) and further in view of Small et al. (4,927,663, hereafter '663).

'677, '701 and '929 teach the limitation of claim 1. They do not teach the fluorescent material comprises a non aqueous-based ultraviolet ink. '663 teach that in

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color printing, a non-aqueous ultra violet (UV) ink can be used [col3, lines 37-40].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used a non aqueous UV ink because '663 teaches that it is a suitable element for color printing.

8. Claims 11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin ('677), Torgersen et al. ('701) further in view of Liu et al. ('929) as applied to claim 1 and 17 above, and further in view of Marsek (5,104,711, hereafter '711).

With respect to claim 11, '677, '701, and '929 teach the limitations of claims 1 and 17. They do not teach that the paint is a urethane-based paint. '711 teach that urethane paint is used to paint a vehicle. [col 1, line 21-22]. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used urethane paint because '711 teach that it is a suitable paint for vehicles.

With respect to claim 18, '677, '701, and '929 teach the limitations of claim 17. They do not teach the paint being urethane-based. '711 teach that urethane paint is applied to the painted vehicle [col 1, line 21-22]. Therefore it would have been obvious to one of ordinary skills in the art at the time the invention was made to have used urethane paint to paint the vehicle because '711 teaches that it is a suitable paint for vehicles.

9. Claim 16 is rejected over Gosselin ('677), Torgersen et al. ('701) and Van Duynhoven ('563) as applied to claim 15 and further in view of Marsek ('711) for substantially the same reasons given for claim 11.

10. Claim 19 - 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin (patent number 5,885,677 hereafter '677) in view of Torgersen et al. (4,303,701, hereafter '701), further in view of Liu et al. (pub number US 2002/0114929 A1 hereafter '929) and further in view of Jack (patent number 5,151,572 hereafter '572).

All the features of claim 19 have been treated above in claims 1 and 5, except recording the unique discrete identification and the unrevealed location on the vehicle surface in a searchable database for retrieval in the event that the vehicle needs to be identified. '572 teaches that the method comprises a computer system [fig 1, 32] including a barcode reader used to read and input various kind of data such as VIN or serial number from automobile components parts... and bulk storage of data [col 3, line 28-49]. It is well known in the art of computer that computer give ability to input data for storage and later retrieve. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have used a computer to not only input VIN but also retrieve data later for whatever reason.

With respect to claim 20, '677 indicates the fluorescent material may be applied directly to the unpainted metal surface [col 5, lines 12-14]. Even though it states that such dyes do not *readily* penetrate the unpainted metal surface, some degree of penetration must occur.

With respect to claim 21, '677 further teach that the UV-fluorescent dye readily penetrates painted metal surface [col 5, lines 12-14].

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11. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin ('677) in view of Torgersen ('701), Liu ('929) and Jack ('572) as applied to claim 19 above further in view of Marsek ('711) for the same reasons given for claim 11 above.

12. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin (patent number 5,885,677 hereafter '677) in view of Torgersen et al. (4,303,701, hereafter '701), further in view of Liu et al. (pub number US 2002/0114929 A1 hereafter '929) and further in view of Jack (patent number 5,151,572 hereafter '572) and further in view of Rohrbaugh et al. (publication number 2002/0176982 A1, hereafter '982).

'677, '701, '929 and '572 teach all the limitation of claim 19. They do not teach the vehicle surface comprises fiberglass, and the unique discrete identification formed by the marking fluid is embedded in the fiberglass. '027 teach that coating can be applied to hard surfaces such as fiberglass and fiberglass includes car bodies [0028]. Therefore it would have been obvious to one of ordinary skills in the art at the time of the invention was made to have applied coating on fiberglass which is part of surface of a vehicle because '982 teaches that coating can be applied to fiberglass of car parts. The coating will inherently penetrate to some degree between fibers of the fiberglass because fiberglass is fibrous.

Allowable Subject Matter

2. Claims 2, 12, 13 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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The prior art does not teach a plurality of layers of paint on the surface and wherein the unique discrete identification is applied to an upper paint layer and the fluorescent material migrates through the upper paint layer and into the at least one lower paint layer.

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 1-23 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-23 of copending Application No. 10707183. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Briget P. Ngampa whose telephone number is 571-270-1866. The examiner can normally be reached on M-F, 830-4:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Cleveland can be reached on 571-272-1418. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

bpn



MICHAEL B. CLEVELAND
SUPERVISORY PATENT EXAMINER